

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant:	Cynthia T. Clague et al.	Examiner:	Pavitra Kotini
Serial No.:	10/694,037	Group Art Unit:	3731
Filed:	October 27, 2003	Docket No.:	M190.242.101/P11210.00
<b>Due Date:</b>	<b>November 29, 2009</b>		
Title:	METHOD AND APPARATUS FOR MAKING PRECISE INCISIONS IN BODY VESSELS		

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**REPLY BRIEF TO EXAMINER'S ANSWER**  
**TO THE BOARD OF PATENT APPEALS AND INTERFERENCES**

**Mail Stop Appeal Brief – Patents**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**Reply Brief Under 37 C.F.R. §41.41**

This Reply Brief is responsive to the Examiner's Answer mailed September 29, 2009, and supports the Notice of Appeal filed on March 11, 2009, appealing from the final rejection dated December 11, 2008, of claims 1-6, 15-23, and 32-34 of the above-identified application. All of these claims remain for consideration.

The U.S. Patent and Trademark Office is hereby authorized to charge required fees or credits due to Deposit Account No. 50-0471 at any time during the pendency of this application.

## **ARGUMENT**

All arguments presented in Appellant's Brief are incorporated by reference herein. Further, Appellant responds to the Examiner's Answer as follows.

### **1. Reply to the Answer Regarding the Rejection of Claims 1-3 and 18-20**

Claims 1-3 and 18-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Shapiro U.S. Patent No. 5,314,440 in view of Taylor et al. U.S. Patent No. 6,387,108. This rejection includes currently pending independent claims 1 and 18. Both claims 1 and 18 include the features "the a fixed cutting blade . . . extend[ing] substantially laterally to the instrument shaft axis . . . the fixed cutting blade having a blunt distal leading blade side and a proximal, trailing side having a fixed cutting edge." The Answer, at page 3, cites Shapiro for this teaching.

The Answer distills the issues of the Appeal to the claim features of "wherein the fixed cutting edge of the proximal trailing side is generally straight along the direction of the laterally extending fixed cutting blade, and wherein the blunt distal leading blade side includes a major portion spaced-apart from the cutting tip, wherein the major portion extends generally perpendicular to the proximal trailing side" as required in the independent claims. The Answer admits Shapiro fails to disclose these features, but then cites Taylor for this teaching.

Appellants respectfully submit that Taylor does not teach or make obvious these claimed features. First, the Answer states, on page 7, that Taylor teaches "the fixed cutting edge of the proximal trailing side which is generally straight." Appellants respectfully submit that Figure 6b of Taylor clearly shows the proximal trailing side is hooked in shape throughout the length of the cutting edge. Thus, Taylor does not meet the features of "generally straight along the direction of the direction of the laterally extending fixed cutting blade" as required in the independent claims.

Second, the Answer states, on page 7, that Taylor teaches that a "major portion of the blunt distal leading side [extends] generally perpendicular to the proximal trailing side." Accepted uses of the feature "parallel" in the art include the aspects of extending in the same direction, equidistant at all points, and never converging or diverging. Figure 6b does not show

**Appellant's Reply Brief to Examiner's Answer to the Board of Patent Appeals and Interferences**

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that any selected portion of the distal and proximal sides are parallel to each other because the sides continuously diverge from the tip of the cutting blade to the shaft. Thus, Taylor does not meet the features of “the blunt distal leading blade side includes a major portion spaced-apart from the cutting tip, wherein the major portion extends generally perpendicular to the proximal trailing side” as required in the independent claims.

Assuming for the sake of argument that the references did include the features separately, the prior art does not make obvious the combination because the motivation to combine the references is missing “a rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 [78 U.S.P.Q.2d 1329] (Fed. Cir. 2006), *cited with approval in* *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1738 [82 U.S.P.Q.2d 1385, 1396] (2007). The Answer, states at page 7, Taylor is used “to modify the cutting blades of Shapiro in order to gain advantage of minimized pressure of the blade exerted on the eye during puncturing the eye.” Appellants submit that the pressure of the blade exerted on the eye is not minimized with the modification but remains the same as before. The pressure on the eye used in Shapiro and Taylor is equal because both Shapiro and Taylor have similarly sized pointed tips and the force need to pierce the vessel wall is dependent on the vessel wall not the blade.

Rather, the independent claims 1 and 18 set forth “as the blunt distal leading blade side is applied against the exterior surface of the vessel wall to depress the vessel wall and into the lumen of the body vessel,” which is relevant to showing the claim features are not obvious in view of the prior art. As a preliminary matter, Appellant traverse the conclusion in the Answer at page 5 that these features amount to merely a statement of use and does not impose structural limitations on the claims. The last paragraph of 35 U.S.C. 112 permits claim features to be described in terms of what they do rather than just in terms of what they are. With regard to non-obviousness, Appellants have discovered a method of making an incision not recognized in the prior art. The teachings of Shapiro or Taylor do not provide instruments that are adequately suited to perform this method. The prior art does not recognize the problem and therefore does not make obvious the combination of Shapiro and Taylor.

**Appellant's Reply Brief to Examiner's Answer to the Board of Patent Appeals and Interferences**

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Appellants submit the above-described features of the independent claim are not shown in either of the references separately and therefore cannot be found in any proposed combination of the reference. Further, the motivation used to combine the references is misplaced, and the prior art does not make obvious modifications to obtain the independent claims. Accordingly, Appellants submit that the independent claims are patentably distinguishable from the prior art combination of Shapiro and Taylor. The dependent claims are also patentably distinguishable for reasons discussed in the Appeal Brief.

**2. Reply to the Answer Regarding the Rejection of Claims 4-6, 15-17, 21-23, and 32-34**

Claims 4-6, 15-17, 21-23, and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro US Patent No. 5,314,440 in view of Taylor et al. US Patent No. 6,387,108 as applied to independent claims 1 and 18 above and further in view of the Taylor et al. US Patent No. 6,036,641. The second Taylor reference does not teach or make obvious the missing features from the independent claims set forth above. Further, these dependent claims are also patentably distinguishable for reasons discussed in the Appeal Brief.

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**CONCLUSION**

For the foregoing reasons, Applicant believes all the pending claims are in a condition for allowance and should be passed to issue. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to contact either Jeffrey J. Hohenshell at Telephone No. (763) 505-8426 or Rudolph P. Hofmann at Telephone No. (612) 573-2010.

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Respectfully submitted,

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